

REMARK/ARGUMENTS

Applicants respectfully request reconsideration of this application in view of the foregoing amendments to the claims and the following comments.

In the Office Action mailed February 8, 2006, claims 1-28 were examined and rejected as follows:

- Claims 1, 7, 13, and 19 were rejected under 35 U.S.C. § 102(e), as allegedly anticipated by U.S. Patent No. 6,432,327 to Beeloo et al. (the "Beeloo patent").
- Claims 2-6, 8-12, 14-18, and 20-24 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Beeloo patent in view of U.S. Patent No. 6,177,032 to Smith et al. (the "Smith patent").
- Remaining claims 25-28 were not expressly rejected on any basis, although the Office Action cover sheet indicated that they were rejected.

Applicants respectfully traverse these rejections for the reasons set forth below.

I. The Anticipation Rejection of Claims 1, 7, 13, and 19

Claims 1, 7, 13, and 19 were rejected under 35 U.S.C. § 102(e), as allegedly anticipated by the Beeloo patent. The Beeloo patent discloses a process for actively forming a PET polarizing film into a prescribed curvature for subsequent incorporation into an optical-quality plastic part. In the disclosed method, a PET film 56 is bridged across the edges of a pre-heated, concave lower mold surface 52, and an upper mold having a sealing surface 58 then is lowered into contact with the film, to secure the film's peripheral edge. The PET film 56 is held in that position for a prescribed time duration, while the film is warmed by residual heat from the lower mold surface 52. A molding pressure then is applied to the upper side of the warmed film, e.g., by a pressurized gas, to urge the film into conforming engagement with the lower mold surface 52. This "active forming" of the film into a different curved shape is accomplished using a preferred pressure range of approximately 10-20 psi. The mold then is opened and the formed PET film is removed for further processing.

In rejecting claims 1, 7, 13, and 19, the Examiner asserted as follows:

Beeloo et al (Fig. 2) discloses the instant method of preconditioning an insert to be used in injection molding lenses by placing the insert (polarizer film 56) in position against a molding surface (52), the molding surface having been heated so that; the film itself becomes heat-soaked. Example 1 teaches (and Figure 2 shows) that the film is initially flat prior to being heat-soaked by the mold, and hence the curvature of the insert is measurably different from the curvature of the molding surface. Given that seal 60 presses a portion of the film against the mold surface 52, it is submitted that such would encompass the instant step of "placing the . . . insert . . . in position . . . against . . . molding surface" as set forth in claims 1 and 13."

Applicants respectfully disagree with the Examiner's assertions regarding the relevance of the Beeloo patent. Broadly, the Beeloo process is concerned with *actively forming* an optical part insert into a new curvature, and it does so by urging the insert against a molding surface using pressurized gas. This contrasts with Applicants' claimed invention, which seeks only to warm the insert, without the need to form it into a new curvature, and certainly without the need to actively form it into a new curvature by applying a pressure to one side of the insert.

By this Amendment, Applicants have amended independent claims 1 and 13 to define the method of the invention with greater specificity and thereby to distinguish more clearly over the Beeloo patent. Specifically, Applicants have amended claims 1 and 13 to state that the insert is placed in a "position resting against a molding surface" and then heat-soaked "without the application of pressure." This contrasts with Beeloo's method, which contemplates only placing the insert in a position that "bridges" a mold surface, and which requires the application of a pressure to one side of the insert, to "actively form" it against the mold surface.

Applicants also have amended independent claims 1 and 13 to state that the molding surface against which the insert is placed is a part of a mold cavity "configured for use in injection molding the optical part." This contrasts with Beeloo's mold surface, which is used only for actively forming the PET insert; it is not specified as being configured for subsequent use in injection molding a laminated optical part incorporating the PET insert. As mentioned above, the formed insert must be *removed* from the mold for further processing and integration with other components of the optical part. *See, Beeloo* patent, col. 6, lines 48-64.

Applicants also have amended independent claims 1 and 13 to state that, in the step of heat-soaking, the insert "is warmed but does not lose its structural integrity." This contrasts with Beeloo's method, which calls for not only warming the insert, but also actively forming it into a new shape. As indicated in paragraph [0028] of Applicants' specification, the inventors found that such mere warming was surprisingly successful at pre-conditioning the insert even when the curvature of the insert was measurably different from the shape of the mold cavity.

For these reasons, independent claims 1 and 13, and their respective dependent claims 7 and 19, now more clearly define a method not shown or suggested in the Beeloo patent. The rejection of claims 1, 7, 13, and 19, therefore, is improper and should be withdrawn.

II. The Obviousness Rejection of Claims 2-6, 8-12, 14-18, and 20-24

As mentioned above, claims 2-6, 8-12, 14-18, and 20-24 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Beeloo patent in view of the Smith patent. Applicants respectfully traverse this rejection for the reasons set forth below.

In making this obviousness rejection, the Examiner acknowledged the failure of the Beeloo patent to disclose "the aspects of the insert preferentially absorbing the energy used for the soaking, that IR energy is used, as well as microwave, UV and RF and that a multilayered insert is used." The Examiner asserted, however, that it "would have been obvious to have employed IR heat to heat-soak the film in Beeloo et al as generally taught by Smith et al." Applicants respectfully disagree, but note that even if the Examiner's assertion were correct, the so-modified method still would not correspond to the invention defined in claims 2-6, 8-12, 14-18, and 20-24.

The secondary Smith patent fails to make up for the deficiencies of the primary Beeloo patent, noted above in connection with the anticipation rejection of claims 1, 7, 13, and 19. Specifically, the Smith patent discloses a method of thermoforming a polarized ophthalmic lenses, in which a polarized, multilayer sheet, or sub-laminate, is initially pre-formed in a vacuum fixture. As described at col. 7, lines 5-44, and as shown in FIGS. 3 and 4, of the Smith patent, a flat polarized, multilayer sub-laminate is placed in a vacuum fixture and then exposed first to infrared heat and then to a vacuum, to actively form the sub-laminate into a

desired curvature. The patent lacks any suggestion that the polarized sub-laminate be conditioned *without* the application of a vacuum. After vacuum forming to the desired curvature, the sub-laminate is removed from the vacuum fixture, for further lamination with other components to produce an ophthalmic lens.

Thus, like the Beeloo patent, the Smith patent fails to disclose a method of pre-conditioning an insert in which the insert is placed in a position resting against a molding surface of a mold cavity, and in which the insert is warmed without the application of a pressure or vacuum. Moreover, the Smith patent fails to disclose a method of pre-conditioning an insert using a mold cavity specifically configured for subsequent use in injection molding an optical part. As such, even if the Beeloo method were to be modified to incorporate features of the Smith method, the resulting modified method still would not correspond to Applicants' claimed invention.

For these reasons, the rejection of claims 2-6, 8-12, 14-18, and 20-24, as allegedly obvious over the Beeloo patent in view of the Smith patent, is improper and should be withdrawn.

III. Dependent Claims 25-28

As mentioned above, the cover sheet of the office Action indicated that claims 25-28 were rejected, but the body of the Office Action failed to set forth any basis for such rejection. For this reason, Applicants are unable to present any arguments regarding the rejection. It bears note, however, that claims 25-28 all depend from amended independent claim 13 and therefore define the invention with even greater particularity. Inasmuch as independent claim 13 defines a patentable invention, dependent claims 25-28 should define a patentable invention, as well. For this reason, the unspecified rejection of dependent claims 25-28 should be withdrawn.

IV. Amendment to Title of the Invention

By this Amendment, Applicants have amended the Title of the Invention to more accurately reflect the claimed invention of a method of pre-conditioning an insert for use in injection molding an optical part.. This reflects the cancellation of claims 29-35 in response to the prior restriction requirement.

V. Comment re Printing Errors in Pat. Appl. Publication No. US 2004/0262791 A1

Applicants have noted the following typographical errors in the Patent Application Publication No. US 2004/0262791 A1, and they request the Examiner to ensure that these errors are avoided when printing any patent based on this present application:


- In Table I, following paragraph [0046], in the column headed "Results: lens optics," for Ex. # 9, "weal" should be "weak".
- In paragraph [0006], the colon ":" in the fourth sentence should be deleted.

VI. Conclusion

This application should now be in condition for reconsideration. Allowance of the application is respectfully requested. If the Examiner believes that a telephone conference with Applicants' undersigned attorney of record might expedite prosecution of the application, he is invited to call at the telephone number indicated below.

Respectfully submitted,

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